

### **REMARKS**

This response is intended as a full and complete response to the final Office Action mailed October 27, 2008. In the Office Action, the Examiner notes that claims 106, 108-115 and 117-123 are pending and rejected. The Applicants herein amend claims 106, 115 and 120 to narrow the claims to exclude text streams. In view of the following remarks, Applicant submits that the claims now pending in the application are allowable.

It is to be understood that Applicant does not acquiesce to the Examiner's characterizations of the art of record or to Applicant's subject matter recited in the pending claims. Further, Applicant is not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant response.

#### **35 U.S.C. §103 Rejection of Claims 106, 108-110, 112-115, 117, 118 and 120-123**

Claims 106, 108-110, 112-115, 117, 118 and 120-123 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,999,207 to Rodriguez (hereinafter "Rodriguez") in view of U.S. Patent 5,990,927 to Hendricks (hereinafter "Hendricks U.S. Patent Application Publication 2001/0013021 to Saito (hereinafter "Saito") and U.S. Patent Application Publication 2005/0262542 to DeWeese et al. (hereinafter "DeWeese"). Applicant respectfully traverses the rejection.

Applicant respectfully submits that the combination of Hendricks, Rodriguez, Saito and DeWeese fail to teach or suggest an apparatus comprising a means for multiplexing a non-video data signal with an upstream communication signal, wherein a non-video data signal comprises at least one of: an electronic book, data file, document, spreadsheet, graphic, program, web page or interactive whiteboard and a means for simultaneously displaying the non-video data signal with the television program and a video of the downstream communication signal on the display device, as positively recited by Applicant's independent claims. In an exemplary embodiment of Applicant's invention, a user may send non-video media during a television program and video call. (See e.g., Applicant's specification, p. 94, ll. 9-22). For example, two sports enthusiasts may each watch the same sports event program while engaging in

an interactive picture-in-picture video call to discuss the action and interact on an interactive whiteboard that is displayed simultaneously with the video call and television program. (See *Id.* at page. 99, ll. 8-13).

Applicant respectfully submits that this feature is not taught by Hendricks, Rodriguez, Saito and DeWeese, alone or in any permissible combination.

Hendricks discloses hardware upgrades for a set top terminal. In particular, the Hendricks reference discloses the hardware upgrades as shown in Figures 9a, 9b, 10, 12a and 12b. Hendricks does not teach or suggest the STT having a means for multiplexing a non-video data signal with an upstream communication signal, wherein a non-video data signal comprises at least one of: an electronic book, data file, document, spreadsheet, graphic, program, web page or interactive whiteboard and a means for simultaneously displaying the non-video data signal with the television program and a video of the downstream communication signal on the display device.

Rodriguez and Saito fail to bridge the substantial gap left by Hendricks. Rodriguez discloses a graphical user interface for a videophone in a cable television system that allows the user to access the videophone functionalities with an input control device and a television monitor. This videophone may be implemented as a plug-in device to a set-top box. However, Rodriguez does not teach or suggest the claimed feature of a means for multiplexing a non-video data signal with an upstream communication signal, wherein a non-video data signal comprises at least one of: an electronic book, data file, document, spreadsheet, graphic, program, web page or interactive whiteboard and a means for simultaneously displaying the non-video data signal with the television program and a video of the downstream communication signal on the display device.

Saito discloses an apparatus for data copyright management. (See Saito, Abstract.) Saito also does not teach or suggest a means for multiplexing a non-video data signal with an upstream communication signal, wherein a non-video data signal comprises at least one of: an electronic book, data file, document, spreadsheet, graphic, program, web page or interactive whiteboard and a means for simultaneously displaying the non-video data signal with the television program and a video of the downstream communication signal on the display device.

In addition, DeWeese also fails to bridge the substantial gap left by Hendricks, Rodriguez and Saito because DeWeese also fails to teach or suggest a means for multiplexing a non-video data signal with an upstream communication signal, wherein a non-video data signal comprises at least one of: an electronic book, data file, document, spreadsheet, graphic, program, web page or interactive whiteboard and a means for simultaneously displaying the non-video data signal with the television program and a video of the downstream communication signal on the display device. In general, DeWeese only discloses a television chat system. Notably, DeWeese simply teaches the ability to chat with another person while watching a video. DeWeese does not teach or suggest that a no-video data signal may be multiplexed with an upstream communication signal comprising at least one of: an electronic book, data file, document, spreadsheet, graphic, program, web page or interactive whiteboard.

Furthermore, the Examiner submits that DeWeese reads on upstream multiplexing in disclosing that "since the upstream communication is over the same medium (cable) as the downstream signal, the upstream signal is inherently multiplexed (using at least TDMA or FDM techniques)." (See Office Action, pp.6-7). The Applicants note that for the Examiner to use an inherency argument the MPEP §2112(IV) requires "the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

First, the Applicants note that DeWeese does not teach that the upstream communication is necessarily over the same "medium". For example, shared transport techniques may include multiple channels within the same medium without multiplexing the signals. DeWeese is consistent with this approach as DeWeese teaches the use of multiple channels. (See DeWeese, para. [0056]). Moreover, if the two-way communications are used, a second communications path such as a satellite link is used. (See *Id.*).

Moreover, even if DeWeese is broadly interpreted, simply because two streams of data are carried on the same medium does not mean that the two streams are necessarily multiplexed. For example, two streams of data may be sent separately at different times over the same medium. That is, multiplexing implies simultaneously sending two signals over the same medium. However, simply because two signals are carried over the same medium does not require that they be sent simultaneously using multiplexing over the same medium.

Thus, as previously argued, the Applicant submits that the reason the Examiner is unable to explicitly find multiplexing a non-video data signal with an upstream communication signal is because DeWeese fails to teach or suggest this limitation. At best, as noted by the Examiner, DeWeese only teaches transmitting “real-time communications in a chat group” over coaxial cables “that also carry television signals.” See, DeWeese, page 1, paragraph 14, emphasis added. Notably, nowhere in DeWeese does DeWeese teach or suggest multiplexing a non-video data signal with the “real time communications” (i.e. chatting). As such, DeWeese is silent as to teaching the ability to multiplex non-video data with the upstream communication signal.

Thus, Hendricks, Rodriguez, Saito and DeWeese, alone or in combination, fail to teach or suggest Applicant’s invention as a whole. Moreover, because that feature is not taught or suggested by any of the references, it is improper hindsight to pick and choose the references to recreate this feature when the teaching is only found in Applicant’s disclosure.

As such, Applicant submits that independent claim 106 is patentable under 35 U.S.C. §103(a) over Rodriguez in view of Hendricks, Saito and DeWeese references alone or in combination. Moreover, independent claims 115 and 120 contain substantially similar limitations as those discussed above in regards to claim 106. Therefore, claims 115 and 120 are also allowable under 35 U.S.C. §103. Dependent claims 108-110 and 112-114, 117-118 and 121-123 depend directly or indirectly from independent claims 106, 115 and 120 and recite additional limitations thereof. As such and for at least the same reasons discussed above with respect to claims 106, 115 and 120 these dependent claims are also non-obvious in view of Rodriguez, Hendricks,

Saito and DeWeese alone or in combination under 35 U.S.C. §103. Therefore, Applicant respectfully requests that the rejection be withdrawn.

**35 U.S.C. §103 Rejection of Claims 111 and 119**

The Examiner has rejected claims 111 and 119 under 35 U.S.C. §103(a) as being unpatentable over Rodriguez, Hendricks, Saito and DeWeese in view of U.S. Patent 5,867,227 to Schindler et al. (hereinafter "Schindler"). Applicant respectfully traverses the rejection.

Claims 111 and 119 depend indirectly from independent claims 106 and 115 and recite additional limitations thereof. Moreover, for at least the reasons discussed above, Rodriguez, Hendricks, Sato and DeWeese fail to teach or suggest Applicant's invention as recited in claims 106 and 115. Accordingly, any attempted combination of Rodriguez, Hendricks, Sato and DeWeese with any other additional references, in a rejection against the dependent claims, would still result in a gap in the combined teachings in regards to the independent claims. As such, Applicant submits that dependent claims 111 and 119 are non-obvious and are patentable under 35 U.S.C. §103. Therefore, Applicant respectfully requests that the Examiner's rejection be withdrawn.

**CONCLUSION**

Applicant submits that claims 106, 108-115 and 117-123 are in condition for allowance. Accordingly, reconsideration and allowance are respectfully solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall or Jimmy Kim at (732) 842-8110 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: \_\_\_\_\_

11/27/09

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